

### **Remarks**

Initially, Applicants note that this Office Action sets a three (3) month shortened statutory response period, instead of the usual one month reply period set to reply to a restriction requirement. Applicants are responding within one month of the date of the outstanding Office Action to expedite prosecution of this Application.

### **Election with traverse**

In reply to the Election/Restriction Requirement, Applicants hereby elect, with traverse, the invention of Group I, the backlight unit for a display, claims 1-17 and 19-24, classified in Class 362, subclass 616.

Applicants traverse this requirement for several reasons.

Firstly, the Election/Restriction Requirement fails to correctly set forth which claims belong to the backlight unit for a display, and a liquid crystal display with a backlight.

This restriction/election requirement states that claims 1-17 and 29-34 are drawn to a backlight unit for a display. While Applicants agree that claims 1-17 and claims 19-24 are drawn to a backlight unit for a display, Applicants respectfully submit that claims 18 and 25-28 are also directed to a backlight for a display, as pointed out by Applicants in the Reply to Restriction Requirement filed on April 10, 2006, and that claims 29-34 are clearly directed to a liquid crystal display device having a backlight unit.

This restriction requirement also incorrectly states that claims 18-28 and 35-38, drawn to "a light crystal display device," classified in Class 349, subclass 62. Applicants respectfully submit that they do not claim a "light crystal display device" at all, that claims 18-28 are clearly drawn to a backlight unit for a display device, and that claims 35-38 (sic: 35-38) are clearly directed to a liquid crystal display device using a backlight unit.

As Applicants stated in the April 10, 2006 Reply, claims 1-28 recite a backlight unit for a display device but none of these claims positively recites a liquid crystal display device. On the other hand, claims 29-38 positively recite a liquid crystal display device having a backlight unit.

Secondly, the Office Action has not demonstrated that there is any serious administrative burden on the Examiner to examine all pending claims, i.e., claims 1-38. MPEP §803 makes it clear that for a restriction to be proper, the Examiner must show that (1) the claims are independent and distinct, and (2) there would be a serious burden on the Examiner if restriction is not required. However, at this stage of the prosecution, claims 1-38 have already been searched and examined on the merits. All that is left for the Examiner to do is update the search, which is to be expected at this stage of the prosecution.

Moreover, the outstanding Office Action does not address the issue of whether there is no serious burden on the Examiner. An Examiner cannot overcome this requirement, explicitly set forth in MPEP §803 (that even if the application contains independent and distinct invention, if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits) merely by not discussing it, in complete contravention of MPEP §707.07(f), and then saying that because it was not discussed in the outstanding or previous Office Action by the Examiner, then it can have no merit. This completely violates Applicant's fundamental substantive and procedural due process rights under the Administrative Procedures Act. See in this regard, *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000), as well as MPEP §707.07(a).

The Office Action now states that the invention of Group I and the invention of Group II are related as subcombinations usable together. It characterizes the invention of Group I as a backlit display with a housing, and characterizes the invention of Group II as a display device with an optical shutter. By characterizing the inventions of Group I and Group II as subcombinations usable together, the Office has to only show one way distinctness. In this regard, the Office Action states that the subcombination of Group II has a separate utility as a display device with an optical shutter, and states that the invention of Group I has a separate utility as a backlit display with a housing. Applicants respectfully disagree for a number of reasons.

The inventions of Groups I and II are incorrectly characterized, for reasons stated above.

Also, the invention of Group II, said to be a light (sic: liquid) crystal display device, is actually a combination of a backlight unit and a liquid crystal panel lit by the backlight device, and

is not, as alleged, a subcombination usable together with the invention of Group II, which is actually a backlight unit that is a subcombination of a liquid crystal display.

Thus, the Office Action uses the wrong test to demonstrate that the Applicants are claiming independent and distinct inventions. Applicants respectfully submit that the correct test is set forth in MPEP §806.05(c) because Applicants are claiming a combination (claims 29-38 and a subcombination (claims 1-28) usable in a combination. Unfortunately, that test is not addressed in this Office Action.

Moreover, for reasons presented in the Reply filed on April 10, 2006, the Office Action fails to meet that test.

Thirdly, Applicants have been put to the expense of replying, in an amendment filed on January 5, 2006, on the merits, under 37 CFR §1.111, to the Office Action dated October 5, 2005, which treats all claims, i.e., claims 1-38, on their merits. This Office Action, which completely fails to respond to all of the arguments made by Applicants in the Amendment filed on June 5, 2006, is a prime example of piecemeal prosecution, which is inconsistent with "compact prosecution" advocated by the USPTO, is to be avoided in patent prosecution, and is fundamentally unfair to Applicants because it denies Applicants treatment of the arguments presented on the merits with respect to a large number of claims that were treated on their merits, and attempts to require Applicants to pay for filing and prosecuting a separate application, especially where the Office has stated that claims in both invention Groups are allowed.. There is no serious administrative burden on the Examiner to examine all the claims.

Fourthly, the Office Action dated October 5, 2005 clearly indicates that claims 1-25 and 29-36 are allowed, and that claim 38 contains allowable subject matter. In other words, claims that the Office Action indicates as allowable are claims in both invention Groups. This is additional evidence that there is no serious burden on the Office to examine claims directed to both invention Groups, especially when one considers that MPEP §803, second paragraph, clearly states that even if restriction is improper, if all of the claims can be examined without special burden, restriction must not be made.

For at least these reasons, the Election/Restriction Requirement is clearly improper and

should be withdrawn, and the Examiner is respectfully requested to examine all 38 pending claims on their merits.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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